



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/770,882	01/26/2001	James D. Hempleman	PRE2519P0011US	6661

7590 09/23/2002
WELSH & KATZ, LTD.
120 SOUTH RIVERSIDE PLAZA
22ND FLOOR
CHICAGO, IL 60606

EXAMINER

KINDRED, ALFORD W

ART UNIT	PAPER NUMBER
----------	--------------

2172

DATE MAILED: 09/23/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/770,882

Applicant(s)

HEMPLEMAN ET AL.

Examiner

Alford W. Kindred

Art Unit

2172

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on ____.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 30-119 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 30-119 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

1. This action is responsive to communications: Amendment C, filed on 07/08/02.

This action is made final.

Claim Rejections - 35 U.S.C. § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --
(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371© of this title before the invention thereof by the applicant for patent.

3. Claims 30-45, are rejected under 35 U.S.C. 102(e) as being anticipated by **Contois**, US# 5,864,868, 01/1999.

As per claim 30, Contois teaches "a source of works . . . an audio component . . . " (see fig. 4—sheet 4 of 8) building a displayable inventory of works . . . play list of works . . . " (see abstract) "additional instructions for creating an editing command . . . editing the displayed . . . "(see col. 5, lines 6-25).

As per claim 31, Contois teaches "presenting a play list to the output device" (see fig. 4—sheet 3 of 8).

As per claim 32, Contois teaches "a device for storage of digital representation . . . " (see col. 3, lines 61-65).

As per claim 33, Contois teaches "edit one of an audio output device . . ." (col. 4, lines 38-62).

As per claim 34, Contois teaches "a programmable processor" (see col. 6, lines 47-60).

As per claims 35 and 38, Contois teaches "analysis of the characteristics of works on a selected list" (see col. 9, lines 42-66).

As per claims 36 and 37, Contois teaches "sorting works accordance with a pre-selected parameter" (see abstract).

As per claim 39, Contois teaches "download a work on a selected play list . . ." (see fig. 1, whereas the serial MIDI (28) is used to download MIDI files).

As per claims 40 and 42, these claims are rejected on grounds corresponding to the arguments given above for rejected claim 30 and are similarly rejected.

As per claim 41, this claim is rejected on grounds corresponding to the arguments given above for rejected claim 33 and is similarly rejected.

As per claim 43, Contois teaches "displaying at least part of the edited list" (see fig. 3—sheet 3 of 8).

As per claims 44 and 45, these claims are rejected on grounds corresponding to the arguments given above for rejected claim 39 and is similarly rejected.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

Art Unit: 2172

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 46-66 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Contois**, as applied to claims 30-45 above, and further in view of **Bernard et al.**, US# 5,918,213.

As per claims 46 and 47, this claim is rejected on grounds corresponding to the arguments given above for rejected claim 34 and is similarly rejected including the following:

--Contois does not teach "royalty payment, or , billing information.

Bernard et al. teaches "royalty payment, or, billing information" (see col. 7, lines 38-55). It would have been obvious at the time of the invention for one of ordinary skill in the art to have combined the teachings of Bernard "royalty payment, or, billing information" (see col. 7, lines 38-55) with the teachings of Contois above, because using the steps of "royalty payment, or, billing information" would have given those skilled in the art the tools to track and gauge the purchasing of musical items.

As per claims 48-49, 58, these claims are rejected on grounds corresponding to the arguments given above for rejected claims 30 and 46 and are similarly rejected.

As per claim 50, this claim is rejected on grounds corresponding to the arguments given above for rejected claim 45 and is similarly rejected.

As per claims 51-52, these claims are rejected on grounds corresponding to the arguments given above for rejected claim 44 and are similarly rejected.

As per claims 53-55, these claims are rejected on grounds corresponding to the arguments given above for rejected claims 42-43 and are similarly rejected.

As per claim 56, this claim is are rejected on grounds corresponding to the arguments given above for rejected claim 30 and are similarly rejected.

As per claim 57, this claim is rejected on grounds corresponding to the arguments given above for rejected claim 36 and is similarly rejected.

As per claim 59, this claim is rejected on grounds corresponding to the arguments given above for rejected claim 44 and is similarly rejected.

As per claim 60, this claim is rejected on grounds corresponding to the arguments given above for rejected claim 50 and is similarly rejected.

As per claim 61-62, these claims are rejected on grounds corresponding to the arguments given above for rejected claim 37 and are similarly rejected.

As per claims 63 and 66, these claims are rejected on grounds corresponding to the arguments given above for rejected claims 48 and 50 are similarly rejected.

As per claims 64-65, these claims are rejected on grounds corresponding to the arguments given above for rejected claim 37 and are similarly rejected.

As per claims 67-116, these claims are rejected on grounds corresponding to the arguments given above for rejected claims 30-45 and 46-66 above and are similarly rejected.

As per claims 117-119, these claims are rejected on grounds corresponding to the arguments given above for rejected claims 40-46 and are similarly rejected.

Response to Arguments

6. Applicant's arguments filed 7/8/02 have been fully considered but they are not persuasive.

As per applicant's arguments regarding "in support of the rejection, the Examiner has referred to col. 5, lines 6-25 . . . however, a review of that section of text provides no discussion whatsoever of editing features . . .", examiner maintains that Contois teachings on col. 5 and col. 11, (i.e. "control means" and "interface means"), clearly teaches an editing element to a structure via a user interface and therefore teach applicant's claim of editing features.

As per applicant's arguments regarding "figs. 2-4 is limited to permitting a user to add songs to a list . . .", examiner maintains the figs. 2-4 is not limited to permitting a user to add songs, but teaches applicant claim invention of view and selecting works on a selected list (i.e. songs).

As per applicant's arguments regarding "presenting downloaded advertisement", examiner maintains that Contois's teaching transferring data files clearly has the capacity to contain advertisement and therefore reads on applicant's claim language above.

As per applicant's arguments regarding "In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that

Art Unit: 2172

obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Contois deals with enabling a user to create and edit play lists and Bernard et al. deals with purchasing multimedia items electronically. Both Contois and Bernard are related to the transfer of audio data in a networking environment and therefore one of ordinary skill in the art would have been motivated to combine both references to arrive at applicant's invention.

As per applicant's argument regarding "in the absence of 'royalty payment, or, billing information", examiner maintains that Bernard teaches billing information as can be seen in col. 7, lines 35-56 (i.e. "automated product purchasing system . . ."), clearly teaches billing information in a manner described by the applicant's claim language.

Conclusion

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

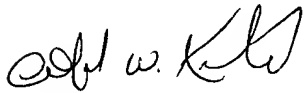
8. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alford W. Kindred whose telephone number is 703-305-3802. The examiner can normally be reached on Mon-Friday, 8:00am-5:00pm.

10. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kim Vu can be reached on 703-305-4393. The fax phone numbers for the organization where this application or proceeding is assigned are 703-746-7239 for regular communications and 703-746-7238 for After Final communications.

Art Unit: 2172

11. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.



Alford W. Kindred
Patent Examiner
September 20, 2002